REMARKS

In view of the following discussion, the applicants submit that none of the claims now pending in the application are non-enabling, anticipated, or obvious under the respective provisions of 35 U.S.C. §102, §103 and §112. Thus, the Applicants believe that all of these claims are now in allowable form.

REJECTION OF CLAIMS UNDER 35 U.S.C. §102

The Examiner has rejected claims 1, 3-4 and 6 under 35 U.S.C. 102(b) as being clearly anticipated by U.S. Patent No. 5,802,448 ("Brown"). The Applicants respectfully traverse the rejection. Specifically, with respect to claim 1, the Examiner alleges that Brown teaches the claimed method for delivering short-time duration video segments to terminals via communications network as seen in Figures 1 and 4 and column 3, lines 9-60 of the reference. The Examiner specifically indicates that:

> "A user may transmit a request which is received 'from a terminal' corresponding to a selected object, which results in the request being processed by a session manager, processors 410. This processing includes determination of adequate bandwidth to transmit the desired object (col.5:12-16). As seen in Figure 5 at item 525, if a timer has expired the connection is terminated at step 530, meeting the claimed generation of a 'control message indicating whether a transport stream may be discontinued ... to release bandwidth.' This frees up resources needed for delivery, and allows network interface 425 (claimed 'transport stream generator') to determine 'if sufficient bandwidth is available' according to a mathematical relationship set forth in col. 5:18-55. The video segment is inherently 'adapted for presentation at said requesting terminal and including a beginning portion of said video segment' by being in a form acceptable for display by receiver system 105 on TV 125 (Fig. 1)."

In response, Applicants respectfully submit that "(A)nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim" (Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984) (citing Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 U.S.P.Q. 193 (Fed. Cir. 1983) (emphasis added)). The Brown reference fails to disclose each and every element of the claimed invention, as arranged in the claim 1.

Specifically, Brown does not teach (at the very least) the third step of applicants' claim 1 (transmitting a control message from the session manager to a transport stream generator ... a beginning portion of said video segment). That is, the Examiner equates this limitation of the subject invention with step 525 of Figure 5 of Brown. The Examiner has indicated that at step 525 if a timer has expired, a connection is terminated at step 530 (said timer timing a viewer's selection interval when provided with a selection). However, in accordance with the specific written language of the specification of Brown and the Examiner's explicit citation of same, it is respectfully submitted that the provided evidence of a connection being terminated at step 530 of Brown states just that and nothing more. That is, Brown goes no further in indicating whether a specific control message from one part of its interactive communication system is provided to another at this point in the selection process by virtue of the terminated connection. Additionally, even if such a control message were generated, it has nothing to do with releasing bandwidth for transmitting a video sequence. Such control message cannot be for indicating a release of bandwidth because the bandwidth allocation decision is (and by the Examiner's specific wording and the language in the specification of Brown at column 5, lines 12-16) practiced before the timing is begun or a decision of whether the time interval for selection has occurred. That is, the bandwidth allocation decision step of Brown is made at step 510, clearly earlier in Brown's method than that of the subject invention. Accordingly, each and every element of the claimed invention as arranged in claim 1 has not been shown by Brown. Therefore, for at least the reasons discussed above, claim 1 is not taught or disclosed by Brown.

As such, the Applicants submit that independent claim 1 is not anticipated under 35 U.S.C. §102 and is fully patentable thereunder. Furthermore, claims 3-4 and 6 depend, either directly or indirectly, from independent claim 1 and recite additional limitations thereof. As such and for at least the same reasons, the applicants submit that these dependent claims are not anticipated under 35 U.S.C. §102 and are fully patentable thereunder. Therefore, the Applicants respectfully request that the rejections be withdrawn.

REJECTION OF CLAIMS UNDER 35 U.S.C. §103(a)

A. Claim 2

The Examiner has rejected claim 2 under 35 U.S.C. 103(a) as being unpatentable over Brown in view of et al. (U.S. Patent No. 5,751,282, "Girard"). The Applicants respectfully traverse the rejection.

Applicants' explanation of Brown with respect to the §102 rejection is also applicable with respect to the §103 rejection herein. As such, and for brevity, that explanation will not be repeated in as great detail. As indicated, Brown does not teach or suggest the step of transmitting a control message from a session manager to a transport stream generator, said control message indicating whether a transport stream may be discontinued by said transport stream generator to release bandwidth as recited in Applicants' claim 1. Because Applicants' claim 2 depends from claim 1, claim 2 also contains the features (the features of claim 1) not taught or suggested by Brown.

The addition of Girard does not correct the deficiencies of Brown. Girard teaches a system and method for calling video on demand using an electronic programming guide. The Examiner specifically indicates that Brown does not teach that video segments are "delivered as part of an interactive program guide" and offers that Girard teaches video segments transmitted in a program guide as seen with reference to Figure 2 which shown a preview of clipped region 58. Accordingly, the Examiner concludes that it would have been obvious for one skilled in the art at the time of the subject invention to modify the method of Brown by transmitting requested video segments as part of a program guide in order to preview clips that assist a user chooses a program.

In response, it is respectfully submitted that the combination of Brown and Girard as a whole still does not teach of suggest the subject invention. Brown has been shown to be defective in not reciting the specific method steps of the claimed invention and Girard is used only to disclose video segments transmitted within the program guide. The combination of Brown and Girard results in an interactive communication system that displays video segments in a program guide and

performs network resource (or bandwidth) limitations without having a session manager send a control message to a transport stream generator in the manner claimed. As discussed earlier in the prosecution history, Girard is silent with respect to the "transmission of a control message from the session manager to a transport stream generator, where the control message causes the transport stream generator to discontinue a transport stream and to release bandwidth so that another transport stream may be transmitted by the transport stream generator, as recited in Applicants' claim 1.

For prior art references to be combined to render obvious a subsequent invention under 35 U.S.C. §103, there must be something in the prior art as a whole which suggests the desirability, and thus the obviousness, of making the combination. Uniroyal v. Rudkin-Wiley, 5 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988). Moreover, the mere fact that a prior art structure could be modified to produce the claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992); In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). Nowhere in the combination of references is there any teaching, suggestion, or incentive to include a control message sent from the session manager to the transport stream generator which allocates available bandwidth. Therefore, the combined references fail to teach the Applicants' invention as a whole. As such, the applicants submit that claim 2 (at least for its dependency upon non-obvious independent claim 1) is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Therefore, the Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. §103 rejection.

B. Claims 5

The Examiner has rejected claim 5 under 35 U.S.C. §103(a) as being unpatentable over Brown in view of U.S. Patent 5,559,549 ("Hendricks"). Applicants respectfully traverse the rejection.

Applicants' explanation of Brown with respect to the §102 rejection is also applicable with respect to the §103 rejection herein. As such, and for brevity, that

explanation will not be repeated in as great detail. As indicated, Brown does not teach or suggest the step of transmitting a control message from a session manager to a transport stream generator, said control message indicating whether a transport stream may be discontinued by said transport stream generator to release bandwidth as recited in Applicants' claim 1. Because Applicants' claim 5 depends from claim 1, claim 5 also contains the features (the features of claim 1) not taught or suggested by Brown.

The addition of Hendricks does not correct the deficiencies of Brown. Hendricks discloses a digital television program delivery system that provides subscribers with a menu-driven access to an expanded television program package. The system allows for a number of television signals to be transmitted by using digital compression techniques. However, Hendricks is silent with respect to the transmission of a control message by the session control manager, as recited in Applicants' claim 1.

As discussed in Section A of this obviousness argument, for prior art references to be combined to render obvious a subsequent invention under 35 U.S.C. §103, there must be something in the prior art as a whole which suggests the desirability, and thus the obviousness, of making the combination. Nowhere in the combination of references is there any teaching, suggestion, or incentive to include a control message sent from the session manager to the transport stream generator which allocates available bandwidth. Therefore, the combined references fail to teach the Applicants' invention as a whole. As such, the applicants submit that claim 5 (at least for its dependency upon non-obvious independent claim 1) is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Therefore, the Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. §103 rejection.

C. **Claims 7 and 8**

The Examiner has rejected claims 7 and 8 under 35 U.S.C. §103(a) as being unpatentable over Brown. Applicants respectfully traverse the rejection.

Applicants' explanation of Brown with respect to the §102 rejection is also applicable in this section. As such, and for brevity, those comments will not be repeated. As indicated above, Brown does not teach or suggest Applicants' claim 1. In addition Applicants' claims 7 and 8 depend (either directly or indirectly) from claim 1 and recite additional features of the invention. The Examiner had previously (in the June 5, 2003 Office Action) taken Official Notice that it is well known in the art to transmit an upstream release message from a terminal to a headend in accordance with claim 7, and tracking by the session manager of video segments being acquired by at least one terminal in accordance with claim 8. The Examiner, in his Final Office Action, then indicates that since Applicants had failed to adequately traverse the Official Notice of the June 5, 2003 Office Action, these statements are taken as admitted prior art per M.P.E.P. 2144.03(c). For the sake of clarity, Applicants note that per M.P.E.P. 2144.03(b), "(T)he Examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 U.S.P.Q. at 801; *Chevenard*, 139 F.2d at 713, 60 U.S.P.Q. at 241. The applicant should be presented with the explicit basis on which the Examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made." Since the Examiner had not provided any explicit basis for his conclusion of common knowledge with respect to these particular aspects of the invention, there was in fact no Official Notice taken to be properly traversed. As such, the statements should not now be taken as official knowledge or prior art at this time.

Notwithstanding dispensation of the Examiner's comments regarding Official Notice, it is respectfully submitted that these additional features (that are alleged prior art) still do not, as a whole, when combined with the teachings of Brown teach or suggest Applicants' invention. That is, Brown in combination with the alleged Official Notice information still does not properly suggest the step of generating a control message by a session manager in the manner claimed. Applicants respectfully submit that at least for the reasons presented above, claims 7 and 8 are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are

patentable thereunder. Therefore, the Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. §103 rejection.

D. **Claims 9-14**

The Examiner has rejected claims 9-14 under 35 U.S.C. §103(a) as being unpatentable over Brown in view of Aharoni et al. U.S. Patent No. 6,014,694 (Aharoni). Applicants respectfully traverse the rejection.

Applicants' explanation of Brown with respect to the §102 rejection is also applicable in this section. As such, and for brevity, those comments will not be repeated. The addition of Aharoni does not correct the deficiencies of Brown. Aharoni discloses transporting video over networks wherein the available bandwidth varies with time. Specifically,

> [t]he system comprises a video/audio codec that functions to compress, code, decode and decompress video streams that are transmitted over networks having available bandwidths that vary with time and location. Depending on channel bandwidth, the system adjusts the compression ratio to accommodate a plurality of bandwidths ranging from 20 Kbps for POTS to several Mbps for switched LAN and ATM environments. See Aharoni Abstract.

Additionally, the Examiner provides alleged support in Aharoni for the various dependent features recited in claims 9-14; however, Aharoni is also silent with respect to the transmission of a control message from the session manager, as recited in Applicants' claim 1. Nowhere in the combination of references is there any teaching, suggestion, or incentive to include a control message from the session manager to the transport stream generator indicating whether a "transport stream may be discontinued by the transport stream generator to release bandwidth ...," as recited by the Applicants.

Therefore, the combined references fail to teach the Applicants' invention as a whole. As indicated above, Brown or Aharoni do not render Applicants' claim 1 obvious. In addition Applicants' claims 9-14 depend (either directly or indirectly) from claim 1 and recite additional features therefore. As such, the Applicants submit that claims 9-14 are not obvious and fully satisfy the requirements of 35 U.S.C. §103 and

are patentable thereunder. Therefore, the Applicants respectfully request that the rejection be withdrawn.

CONCLUSION

Thus, the Applicants submit that all the claims presently in the application are in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall, Esq. at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

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Respectfully submitted,

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